



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,492	05/17/2005	Hyung-Nam Choi	0112740-1078	3927

29177 7590 07/18/2007
BELL, BOYD & LLOYD, LLP
P.O. BOX 1135
CHICAGO, IL 60690

EXAMINER

GOETZE, SIMON A

ART UNIT	PAPER NUMBER
----------	--------------

2617

MAIL DATE	DELIVERY MODE
-----------	---------------

07/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/535,492

Applicant(s)

CHOI ET AL.

Examiner

Simon A. Goetze

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Action is in response to Applicant's amendment filed on April 23, 2007. **Claims 20-25** were added by the instant amendment. **Claims 13-25** are now pending. **This action is made FINAL.**

Response to Arguments

Applicant's arguments with respect to **claims 13-25** have been considered but are moot in view of the new ground(s) of rejection.

The argued features (of previously presented independent claims 13 and 20), i.e., a method for operating terminals in a wireless local area network environment by storing a plurality of access information pertaining to the mobile radio communication system as well as details for the wireless local area network such as the location, type, and service provided, reads upon Knauerhase et al. in view of Haverinen et al. as follows.

Knauerhase et al. is discussing a system which stores information about connectivity and characteristics of networks in a mobile device. They disclose storing network identifiers of wireless networks. Therefore disclosing the limitation of "storing a plurality of items of access information on a terminal, the access information including at least one first item of identification information for the mobile radio communication a system and at least one second item of identification information for a local area network." They further disclose storing the location of the local area network. Therefore disclosing the limitation of "a first item of network

Art Unit: 2617

information indicating the location of the local area network.” They then discuss storing the type of the local area network. Therefore disclosing the limitation of “a second item of network information indicating the type of the local area network.” They further disclose that a third party provides connection service (e.g. hotspot). Therefore disclose the limitation of “a third item of network information indicating at least one third party service provided by the network.” However, they fail to specifically disclose that this stored information is used to establish a connection to any of the previously mentioned networks. Haverinen et al. discloses this feature by storing network identifiers of networks with which the phone may connect, and then using these identifiers to establish a connection. Therefore disclosing the limitation of “establishing a connection to a local wireless network to receive the third party service based on the stored access information.”

In response to the argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the argument that “the term ‘service’ according to the present invention pertains to a third party applications the network offers or gives access to, not the type of connection” (*see Page 7 of Applicant's Reply*) is not explicitly required by independent claims 13 or 20. Claims 13 and 20 both recite “at least one third party service provided by the local area

Art Unit: 2617

network...” There is no limitation in the claim specifically defining what the third party service may or may not comprise. Therefore, providing connectivity to a user is a reasonable interpretation as a third party service by a local area network.

Regarding the argument that Haverinen et al. teaches away from the Knauerhase et al. system, as cited in Applicant’s reply on Page 7, the Examiner is confused. Haverinen et al. does not have Paragraph 0083 as Applicant has directed the Examiner to review. It is reiterated that Haverinen et al. was incorporated only to show that terminal identifiers stored in a phone are used to aid in system selection.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, they are both from related art, and therefore they can be combined and used to show obviousness with respect to prior art. The motivation to combine is taken from the background of Haverinen et al. If the feature relied upon from Haverinen et al. is taken with Knauerhase et al., the same result is reached. As a result the claims are written such that they read upon the cited art.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Knauerhase et al. (US Patent 6,941,146)** in view of **Haverinen et al. (US Patent Application Publication 2003/0119481)**.

Consider **claims 13 and 20**, Knauerhase et al. discloses a method for operating terminals of a mobile radio communication system, in at least one local wireless network, comprising:

storing a plurality of items of access information on a terminal (*network identifiers of the plurality of networks, e.g. cellular, 802.11, Bluetooth, are stored on the phone – Column 2, Lines 10-16; Column 3, Lines 44-64*),

the access information comprises at least one first item of identification information for the mobile radio communication system and at least one second item of identification information for a local area network (*Column 2, Lines 27-33 and 44-53; Column 3, Lines 44-64; Column 4, Lines 49-57*),

the second item of identification information comprises:

a first item of network information indicating the location of the local area network (*Column 2, Lines 27-33; Column 3, Lines 54-60; Column 4, Lines 49-57*),

a second item of network information indicating the type of the local area network (*read as information regarding the testing of each transceiver is stored – Column 3, Lines 1-8 and 48-51; Column 4, Lines 49-57*), and

a third item of network information indicating at least one third party service provided by the local area network (*read as the types of 802.11 connections available in the area – Column 2, Lines 27-33; Column 3, Lines 1-8; Column 3, Lines 48-60; Column 5, Lines 1-10*).

However, Knauerhase et al. discloses storing the identification information of all monitored transceivers, but fails to specifically disclose storing a mobile radio communication system identifier and establishing a connection to a local wireless network to received the third party service based on the stored information.

In related prior art, Haverinen et al. discloses a method for establishing a roaming arrangement in a network comprising both cellular radio networks and wireless local area networks. Network identifiers are stored in the mobile phone and are used for network selection (*Page 1, Paragraph 0006; Page 3 and 4, Paragraph 0038; Page 4, Paragraph 0042*).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teachings of Haverinen et al. with those of Knauerhase et al. in order to be able to perform a comparison of stored identifiers and received identifiers during network selection.

Consider **claims 14 and 21**, as applied above, Knauerhase et al. as modified by Haverinen et al. further discloses that the second item of identification comprises a fourth item of network information uniquely identifying the local area network (*Knauerhase et al. – Figure 4, record 404 – Column 3, Lines 48-64*).

Consider **claims 15 and 22**, as applied above, Knauerhase et al. as modified by Haverinen et al. further fail to teach that the first, second, and/or third items of network

Art Unit: 2617

information are encoded by means of a maximum of three decimal digits. Official Notice is taken that the advantages of limiting and standardizing the size of stored information is well known and expected in the art. It would have been obvious to make such a restriction on size due to the known limited amount of storage on wireless communications devices and to provide a consistent manner of storing this information on the device.

Consider **claims 16 and 23**, Knauerhase et al. as modified by Haverinen et al. fails to teach that the fourth item of network information is encoded by means of a maximum of five decimal digits. Official Notice is taken that the advantages of limiting and standardizing the size of stored information is well known and expected in the art. It would have been obvious to make such a restriction on size due to the known limited amount of storage on wireless communications devices and to provide a consistent manner of storing this information on the device.

Consider **claims 17 and 24**, as applied above, Knauerhase et al. as modified by Haverinen et al. further discloses that the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification information that are assigned to local area networks which allow the operation of the terminal within the local area network (*Haverinen et al. – employs a common method of storing a list of allowed network identifiers which the mobile station is allowed to roam – Page 4, Paragraph 0042*).

Consider **claims 18 and 25**, as applied above, Knauerhase et al. as modified by Haverinen et al. further discloses that the second items of identification information are stored as a first list organized in such a way that the first list contains those second items of identification

Art Unit: 2617

information that are assigned to local area networks which forbid the operation of the terminal within the local area network (*Haverinen et al. – employs a common method of storing a list of allowed network identifiers which the mobile station is forbidden to roam – Page 4, Paragraph 0042*).

Consider **claim 19**, as applied to claim 13 above, Knauerhase et al. as modified by Haverinen et al. further discloses that the at least first item of access information is stored on a device serving for user identification, in particular a USIM module (*Haverinen et al. – Page 3, Paragraph 0024; Page 4, Paragraphs 0038 and 0042*).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Simon A. Goetze whose telephone number is (571) 270-1113. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and Friday from 7:30am to 4:00pm.

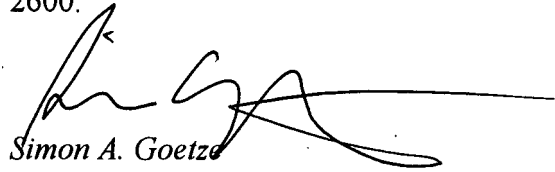
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Art Unit: 2617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-

2600.

A handwritten signature in black ink, appearing to read 'Simon A. Goetze', with a long horizontal stroke extending to the right.

Simon A. Goetze
S.A.G./sag

July 3, 2007

A handwritten signature in black ink, appearing to read 'William Trost', with a long horizontal stroke extending to the right.

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600